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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKETT NO.
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09/253,014 2/19/99 Woolston

EXAMINER

Kemper

ART UNIT	PAPER NUMBER
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2165 24

DATE MAILED:

EXAMINER INTERVIEW SUMMARY RECORD

All participants (applicant, applicant's representative, PTO personnel):

(1) John Phillips (3) _____

(2) Melanie Kemper (4) _____

Date of interview 1/23/01

Type: ☐ Telephonic ☒ Personal (copy is given to ☐ applicant ☐ applicant's representative).

Exhibit shown or demonstration conducted: ☐ Yes ☒ No. If yes, brief description: _____

Agreement ☒ was reached with respect to some or all of the claims in question. ☐ was not reached.

Claims discussed: independent

Identification of prior art discussed: Sharp, Selman (103 ref)

Description of the general nature of what was agreed to if an agreement was reached, or any other comments: _____

Neither Sharp nor Selman appear to discuss the seller initiate an instance of auction process - specifically giving seller control of when the auction takes place - immediately or at a future time. Further search and reconsideration is necessary.

(A fuller description, if necessary, and a copy of the amendments, if available, which the examiner agreed would render the claims allowable must be attached. Also, where no copy of the amendments which would render the claims allowable is available, a summary thereof must be attached.)

☒ 1. It is not necessary for applicant to provide a separate record of the substance of the interview.

Unless the paragraph below has been checked to indicate to the contrary, A FORMAL WRITTEN RESPONSE TO THE LAST OFFICE ACTION IS NOT WAIVED AND MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW (e.g., items 1-7 on the reverse side of this form). If a response to the last Office action has already been filed, then applicant is given one month from this interview date to provide a statement of the substance of the interview.

☐ 2. Since the examiner's interview summary above (including any attachments) reflects a complete response to each of the objections, rejections and requirements that may be present in the last Office action, and since the claims are now allowable, this completed form is considered to fulfill the response requirements of the last Office action. Applicant is not relieved from providing a separate record of the substance of the interview unless box 1 above is also checked.

Melanie Kemper
Examiner's Signature

To: Melanie Kemper, Primary Examiner
U.S. Patent and Trademark Office
Art Unit 2165

From: John C. Phillips
MercExchange, LLC
Tel: 703-549-9590

Fax: 703-308-9051

Pages: 3

Phone: 703-305-9589

Date: 1/21/2001

Re: Ser. No. 09/253,014

CC:

☐ **Urgent** ☐ **For Review** ☐ **Please Comment** ☐ **Please Reply** ☐ **Please Recycle**

● **Comments:**

Examiner Kemper,

As requested, attached is an outline for our interview scheduled for Tuesday, January 23, 2001, at 3:00pm. I look forward to meeting with you then. In the meantime, please feel free to contact me with any questions.

John C. Phillips
Reg. No. 35,322

Outline for Examiner Interview

Serial No. 09/253,014

Melanie Kemper, Primary Examiner

John Phillips, Reg. No. 35,322

Jan. 23, 2001, 3:00pm

- I. Discussion of Woolston invention as automated "person-to-person" auction system in contrast to prior art "single-entity" auctions (e.g., "Army Knives to Gold Coins") under the control of a single entity and requiring operator intervention. — *no intervention in Sharp*
- II. Discussion of proposed amendments to representative independent claim 133:

*obv to
make
automatic
Dr re Vanner
130 USPQ 192
94*

133. (DRAFT) [A] An automated, computer-implemented method of facilitating Internet-based electronic auctions, the method comprising:

receiving information from a seller of an item to be auctioned, the information identifying the item to be auctioned and designating an item category selected by the seller from a list of item categories;

storing the received information in a database of information relating to items to be auctioned;

mapping the received information stored in the database into a presentation format that includes the identifying information and the item category provided by the seller;

displaying the presentation format to a plurality of buyers [the identity of the item to be auctioned in the designated item category];

conducting an online auction for the item including receiving bids on the item from one or more of the plurality of buyers; and

terminating the online auction of the item based on a predetermined condition.

- III. Discussion of applied references: "Army Knives to Gold Coins," Salmon (USP 5,592,375), et al. — none teach or suggest, regardless of how hypothetically combined, an automated, computer-implemented auction process as recited in claim 133.
- IV. Discussion of Objective Evidence of Non-obviousness
- a. Declaration from Professor Jonathon Palmer, Ph.D., expert in electronic commerce business technologies, establishing the following:
- i. Commercial success of "person-to-person" auction systems such as claimed by Woolston over prior art "single entity" auction systems

- ii. A person of skill in the relevant art in April 1995 would not have been motivated to modify prior art "single entity" auctions to include Woolston's "person-to-person" auction features (e.g., seller specifies category under which item is to be auctioned, seller's actions initiate instance of auction process, seller controls timing of auction, etc.)

V. Other Potential Claim Amendments

- a. "An automated, computer-implemented method of conducting Internet-based electronic auctions **under the control of a plurality of independent sellers,**"
- b. Automated, computer-implemented auction system in which **seller's actions automatically initiate instance of auction process**
- c. Automated, computer-implemented auction system in which **seller controls timing and scheduling of auction process**

VI. Discussion of defects in office action mailed Dec. 12, 2000

- a. Page 3, lines 7-12: Improper assertions of inherency -- deeming a feature as "inherently disclosed" requires that the alleged inherency is the **necessary and inevitable** result of practicing what is asserted to embody the inherent disclosure. *In re King*, 231 USPQ 136 (Fed. Cir. 1986)
- b. Pages 4-6 (thirteen separate instances): Improper assertions of official notice -- As explained in MPEP 2144.03, official notice (e.g., asserting a fact or that a claim feature "would have been obvious" without citing a reference in support) can properly be used only to establish facts that capable of "instant and unquestionable demonstration as being well-known." *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). Moreover, official notice may be used only to "fill the gaps" and cannot be used as "the principal evidence upon which a rejection is based," *Ahlert*, 424 F.2d at 1088, or as the motivation for combining or modifying references. *Ex Parte Grochowski*, No. 95-1343, slip op. at 5 (Bd. Pat. App. & Int. June 27, 1995).

Outline for Examiner Interview

Serial No. 09/253,014

Melanie Kemper, Primary Examiner

John Phillips, Reg. No. 35,322

Jan. 23, 2001, 11:00am

I. Discussion of Woolston invention as automated "person-to-person" auction system in contrast to prior art "single-entity" auctions (e.g., "Army Knives to Gold Coins") under the control of a single entity and requiring operator intervention.

II. Discussion of proposed amendments to representative independent claim 133:

133. (DRAFT) [A] An automated, computer-implemented method of facilitating Internet-based electronic auctions, the method comprising:

receiving information from a seller of an item to be auctioned, the information identifying the item to be auctioned and designating an item category selected by the seller from a list of item categories;

storing the received information in a database of information relating to items to be auctioned;

mapping the received information stored in the database into a presentation format that includes the identifying information and the item category provided by the seller;

displaying the presentation format to a plurality of buyers [the identity of the item to be auctioned in the designated item category];

conducting an online auction for the item including receiving bids on the item from one or more of the plurality of buyers; and

terminating the online auction of the item based on a predetermined condition.

III. Discussion of applied references: "Army Knives to Gold Coins," Salmon (USP 5,592,375), et al. – none teach or suggest, regardless of how hypothetically combined, an automated, computer-implemented auction process as recited in claim 133.

IV. Discussion of Objective Evidence of Non-obviousness

a. Declaration from Professor Jonathon Palmer, Ph.D., expert in electronic commerce business technologies, establishing the following:

i. Commercial success of "person-to-person" auction systems such as claimed by Woolston over prior art "single entity" auction systems

- ii. A person of skill in the relevant art in April 1995 would not have been motivated to modify prior art "single entity" auctions to include Woolston's "person-to-person" auction features (e.g., seller specifies category under which item is to be auctioned, seller's actions initiate instance of auction process, seller controls timing of auction, etc.)

V. Other Potential Claim Amendments

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PA24-27

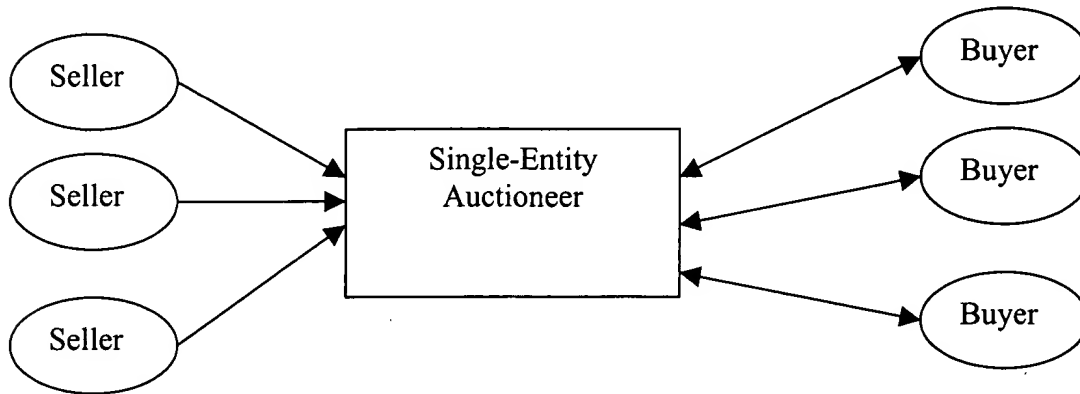
- a. "An automated, computer-implemented method of conducting Internet-based electronic auctions **under the control of a plurality of independent sellers,**"
- b. Automated, computer-implemented auction system in which **seller's actions automatically initiate instance of auction process**
- c. Automated, computer-implemented auction system in which **seller controls timing and scheduling of auction process**
- d. **Multiple, simultaneous seller-initiated auction processes**

VI. Discussion of defects in office action mailed Dec. 12, 2000

- a. Page 3, lines 7-12: Improper assertions of inherency -- deeming a feature as "inherently disclosed" requires that the alleged inherency is the **necessary and inevitable** result of practicing what is asserted to embody the inherent disclosure. *In re King*, 231 USPQ 136 (Fed. Cir. 1986)
- b. Pages 4-6 (thirteen separate instances): Improper assertions of official notice -- As explained in MPEP 2144.03, official notice (e.g., asserting a fact or that a claim feature "would have been obvious" without citing a reference in support) can properly be used only to establish facts that capable of "instant and unquestionable demonstration as being well-known." *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970). Moreover, official notice may be used only to "fill the gaps" and cannot be used as "the principal evidence upon which a rejection is based," *Ahlert*, 424 F.2d at 1088, or as the motivation for combining or modifying references. *Ex Parte Grochowski*, No. 95-1343, slip op. at 5 (Bd. Pat. App. & Int. June 27, 1995).

Auction under Control of Single Entity (aka “Single-Seller” auction)

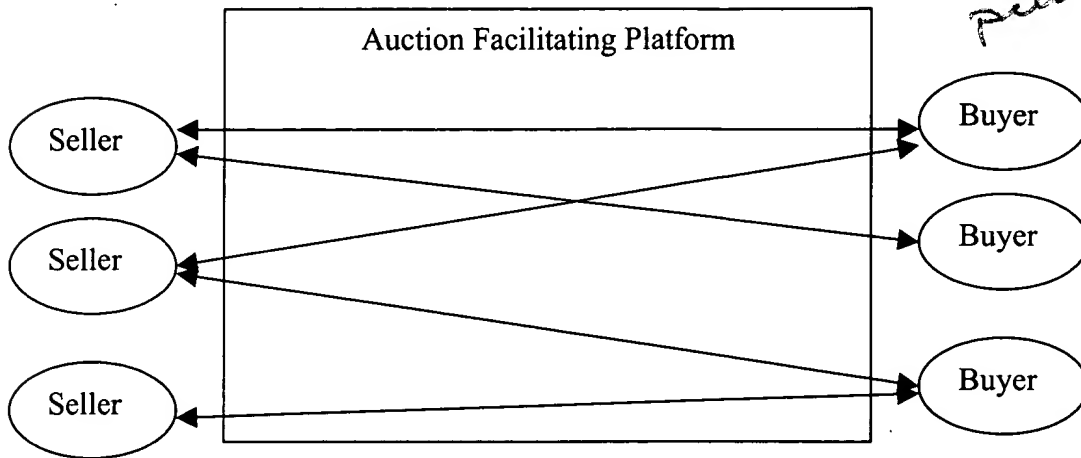
(Army Knives to Gold Coins, Save the Earth, Computer Museum)



- Prior Art Auction systems used central administrator who:
 - Collected, warehoused and verified items to be auctioned
 - Assembled and maintained catalog of item descriptions
 - Decided when, where and how to auction items
 - Shipped goods to winning bidders
 - Etc.

Person-to-Person Auction System

(Woolston auction system)



- Advantages of Person-to-Person auction system include:
 - Auction facilitator incur much less overhead and risk -- need not receive, hold or verify items – rather, merely provides automated, computer-implemented auction mechanisms
 - Opens auction system to wider assortment of sellers
 - Facilitates multiple, simultaneous auctions that result in increased selection and participation
 - Highly scalable - increased flexibility and efficiency
 - Sellers have control over the following:
 - Description and categorization of item to be auctioned
 - Timing and scheduling of auction processes
 - Other auction parameters

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now (immediately or future auction time)